



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,101	04/16/2007	Albrecht Weiss	C 2816 PCT/US	2593
23657	7590	05/11/2010		
FOX ROTHSCHILD LLP 997 Lenox Drive, Bldg. #3 Lawrenceville, NJ 08648				
EXAMINER				
HANLEY, SUSAN MARIE				
ART UNIT		PAPER NUMBER		
1651				
NOTIFICATION DATE		DELIVERY MODE		
05/11/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

Office Action Summary

Application No.

10/595,101

Applicant(s)

WEISS ET AL.

Examiner

SUSAN HANLEY

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-25, 27-29, 31, 33-37 and 45-49 is/are pending in the application.
- 4a) Of the above claim(s) 34-37 and 45-49 is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-25, 27-29, 31 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 20-25, 27-29, 31, 33-37 and 45-49 are pending.

Election/Restrictions

Applicant's election without traverse of Group I, claims 2-40, an emulsion comprising an oil phase selected from the group consisting of a fatty acid alkyl ester and a triglyceride (there is no enzyme present) wherein the oil phase is a fatty acid alkyl ester and the enzyme reaction is a transesterification in the reply filed on 7/17/09 is again acknowledged. The specie election for the choice of an alkyl fatty acid ester or a triglyceride for the emulsion was withdrawn since the prior art discloses an emulsion having both species.

Claims 34-37 stand withdrawn.

Newly submitted claims 45-49 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 45 is directed to a method of carrying out an enzyme-catalyzed reaction in a medium comprising water, at least one emulsifier and an oil phase wherein the emulsion is produced by a phase invention temperature process and the emulsion has a droplet size of 50 to 400 nm and wherein the enzyme-catalyzed reaction is selected from the group consisting of hydrolysis, esterification and transesterification.

This application is a national stage entry of a PCT. Therefore lack of unity of invention applies.

The newly added claims lack unity of invention since the composition as claimed is disclosed by the prior art. Molitor discloses an oil-in-water emulsion comprising water,

emulsifiers and an oil phase prepared by a phase inversion temperature process. The droplet size of the emulsion is 50 to 400 nm (translation, description, page 3/10, lines 3-10 and claim 1). The reference is silent regarding the suitability of the reaction medium for an enzymatic reaction selected from the group consisting of hydrolysis, esterification and transesterification (elected specie) but meets the claimed limitations which indicates that the claimed characteristics should be present in the prior art invention as also as those instantly claimed. Furthermore, microorganisms comprises enzymes. Thus, the enzymes in the microorganisms are carrying out enzymatic reactions. In this case, burden is shifted to the Applicant to distinguish the instant invention over the prior art.

It is noted that In re Best (195 USPQ 430) and In re Fitzgerald (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

The expression "special technical feature" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art (PCT Rule 13.2). Thus, a feature found in the prior art cannot be considered to be a special technical feature.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45-49 are withdrawn from consideration

as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 20-25, 27-29, 31 and 33 are under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 20-23, 25, 27-29, 31 and 33 stand rejected under 35 U.S.C. 102(b) as being clearly anticipated by Molitor et al. (DE 19923785, English translation provided by the EPO and the Derwent abstract thereof) for the reasons given in the last Office action as stated herein.

Claim 20 has been amended to recite in the preamble that the claimed composition has an intended use for an enzyme catalyzed reaction and in the body of the claim that the reaction medium is capable of supporting an enzyme catalyzed reaction selected from the group consisting of hydrolysis, esterification and transesterification. The range of claim 29 has been amended to recite that the ratio of the hydrophilic emulsifier to the hydrophobic emulsifier is 10:90 to 90:10.

Molitor meets the new limitations added to claim 20 because Molitor discloses the components of the claimed composition: water, at least one emulsifier and an oil phase wherein the emulsion is prepared by phase inversion temperature process and the droplet size of the emulsion is 50 to 400 nm. The reference is silent regarding the suitability of the reaction medium for an enzymatic reaction selected from the group

consisting of hydrolysis, esterification and transesterification (elected specie) but meets the claimed limitations which indicates that the claimed characteristics should be present in the prior art invention as also as those instantly claimed. In this case, burden is shifted to the Applicant to distinguish the instant invention over the prior art.

It is noted that *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

Molitor teaches the ration of the hydrophilic emulsifier to the hydrophobic emulsifier is 10:90 to 90:10 (translation, description, page 8/10, lines 2-3 and claim 9) as in amended instant claim 29.

Applicants argue that the claims have been amended to recite a reaction medium for an enzyme-catalyzed reaction comprising water, at least one emulsifier and an oil phase wherein the reaction medium is capable of supporting an enzyme-catalyzed reaction selected from a Markush group and not cell growth.

As noted supra, Molitor meets the new limitations added to claim 20 because Molitor discloses the components of the claimed composition: water, at least one emulsifier and an oil phase wherein the emulsion is prepared by phase inversion temperature process and the droplet size of the emulsion is 50 to 400 nm. The reference is silent regarding the suitability of the reaction medium for an enzymatic

reaction selected from the group consisting of hydrolysis, esterification and transesterification (elected specie) but meets the claimed limitations which indicates that the claimed characteristics should be present in the prior art invention as also as those instantly claimed. Furthermore, microorganisms comprises enzymes. Thus, the enzymes in the microorganisms are carrying out enzymatic reactions. In this case, burden is shifted to the Applicant to distinguish the instant invention over the prior art.

It is noted that In re Best (195 USPQ 430) and In re Fitzgerald (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

Claim Rejections - 35 USC § 102/103

Claims 20-25, 27-29, 31 and 33 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Molitor et al. (DE 19923785, English translation by EPO and the Derwent abstract thereof) for the reasons of record stated in the last Office action as a given herein.

Applicants argue that the claims have been amended to recite a reaction medium for an enzyme-catalyzed reaction comprising water, at least one emulsifier and an oil phase wherein the reaction medium is capable of supporting an enzyme-catalyzed reaction selected from a Markush group and not cell growth. Applicants asserts that in

contrast, the cited prior art utilizes the fatty acid ester/glyceride components as carbon sources or nutrients for the growth of cells.

As noted supra, Molitor meets the new limitations added to claim 20 because Molitor discloses the components of the claimed composition: water, at least one emulsifier and an oil phase wherein the emulsion is prepared by phase inversion temperature process and the droplet size of the emulsion is 50 to 400 nm. The reference is silent regarding the suitability of the reaction medium for an enzymatic reaction selected from the group consisting of hydrolysis, esterification and transesterification (elected specie) but meets the claimed limitations which indicates that the claimed characteristics should be present in the prior art invention as also as those instantly claimed. Furthermore, microorganisms comprises enzymes. Thus, the enzymes in the microorganisms are carrying out enzymatic reactions. In this case, burden is shifted to the Applicant to distinguish the instant invention over the prior art.

It is noted that In re Best (195 USPQ 430) and In re Fitzgerald (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

Double Patenting

Claims 20-23, 25, 28, 29 and 31 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 24, 25, 27-29 and 31-32 of copending Application No. 11/816,419.

Applicants request that the rejection be held in abeyance until the prosecution of 11/816,419 and the present application are more advanced.

The rejection stands for the reasons of record since Applicants have not addressed the specifics of the rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN HANLEY whose telephone number is (571)272-2508. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sandra Saucier/

Primary Examiner, Art Unit 1651

/Susan Hanley/
Examiner, Art Unit 1651